

App. No. 10/826,990
Attorney Docket 3053.2.1 NP

Remarks

Applicant thanks the Examiner for the Written Office Action. In particular, the Applicant thanks the Examiner for the interview which was conducted on September 19, 2007, wherein the Applicant requested clarification regarding the 112 rejections, and the Examiner explained reasons for the 112 objections.

With regard to the substantive portion of the Written Office Action, Claims 1-6 and 21-26 were rejected under 35 U.S.C. 112 for failing to comply with the written description requirement; Claims 1-3, 5-6 were rejected under 35 U.S.C. 102 as being anticipated by Scott (US 5,268,137); Claims 1-3, 5-6 were additionally rejected under 35 U.S.C. 103 as being unpatentable over Groves (US 5,647,154) in view of Bryant (US 2004/0035063); Claims 7-9, and 11 were rejected under 35 U.S.C. 103 as being unpatentable over Groves in view of Bryant and Poole (US 6,484,455); Claims 10 was rejected under 35 U.S.C. 103 as being unpatentable over Bryant in view of Poole (US 6,484,455) in further view of Rygiel (US 6,237,294); Claims 21-22 were rejected under 35 U.S.C. 103 as being unpatentable over Kemerer (US 4,290,248); and finally, Claims 23-25 were rejected under 35 U.S.C. 103 as being unpatentable over Kemerer in view of Glover (US 6,612,091).

In response to the Office Action, the Applicant has amended Claims 1, 7, 21, 24-25 to further distinguish the Applicant's invention over the cited references. Specifically, Claim 1 now includes the limitation of "consisting of". Additionally, Claim 1 has been amended to include "protrusion extending therefrom." Support of the amendments and added claims may be found in the specification and claims as disclosed previously.

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Specifically, support for "rock-shaped protrusions" may be found in Paragraphs 33 and 29. Accordingly, the Applicant believes there is no new matter.

Response to 112 Rejections

In response to the 112 rejections, the applicant has amended Claim 1 to include "consisting of" and has deleted the "consisting essentially." However, Claim 21 includes "consisting essentially of..." and in doing so the Applicant desires to clarify and point out to the Examiner where the material differences are described in the specification as originally filed which would enable one skilled in the art to understand the scope of consisting essentially of and therefore not be indefinite.

As discussed in the previous office action response, the Applicant's inclusion of "consisting essentially of" excludes teachings of Scott and distinguishes the Applicant's invention from Scott. The additional disclosures and/or teachings recited in Scott would clearly materially change the characteristics of the Applicant's invention. The purpose, structure and function of the liner as taught in Scott is vastly different from that of the Applicant invention. First, the purpose in Scott is in creating the appearance of a brick structure on newly poured and wet concrete/cement. The structure as taught in Scott is materially different as the reference Scott teaches not only a liner, but a shallow tray, concrete structure, a tensional member (i.e., mesh, etc.). Additionally, Scott uses and indeed requires a wooden frame or setting (See figures 1-3).

The Applicant submits these material differences are disclosed in the original specification such that one skilled in art would understand that inclusion of the elements taught in Scott would destroy the purpose and materially affect the Claimed invention.

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Indeed, the novel and unique characteristics of the Claimed invention must be clearly disclosed in an applicant's specification. MPEP 2111.03. The Applicant's specification (Paragraph 16) teaches one advantage of the invention is to enable attachment of the invention years after the original structure was built. The structure and components as taught in Scott (not just the Scott method) require newly poured concrete; and the components of the actual liner. In addition, the Applicant's specification contains numerous references, and indeed, only references attaching the liner to a window well. One skilled in the art would clearly understand and realize the scope of the Applicant's invention would disallow and exclude teaching in Scott, such as using a wooden frame, newly poured concrete, etc. (See Figures 1 and 4)

Additionally, while the Examiner is correct in pointing out that the Scott reference and peeling the mold off the wall is directed to a method, the Applicant respectfully submits the entire teachings of Scott must be considered in whether there is question of material differences for the exclusion of elements.

Further, even though the Applicant's specification does not specifically disclose the terms "consisting essentially of", it is still not new matter because all of the included limitations are present and discussed in the Applicant's specification. Indeed, "consisting essentially of" is transitional phrase which is a synonym for "including". Indeed, one skilled in the art would realize that the limitations and/or elements of the consisting essentially of claims as described in the Applicant's specification could be limited to only those elements. Accordingly, the Applicant submits that the inclusion of consisting essentially is proper and should be given proper weight.

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Response to 102 Rejections

In response to the 35 U.S.C. 102 rejections the Applicant believes the newly amended claims are not anticipated by Scott. To be anticipated by 35 U.S.C. 102, a reference must include every element and limitation disclosed in the claims. See MPEP 2131. Further the term "consisting of" excludes any element, step, or ingredient not specified in the claim. See MPEP 2111.03. The Applicant's newly amended Claim 1 include "consisting of", which limits the Applicant's invention to only those limitations specified in Claim 1, namely a flexible first side and second flexible side with a 3-dimensional rock pattern. In contrast to this, Scott includes a liner, a shallow tray, and a concrete structure, a tensional member (i.e., mesh, etc.). Additionally, Scott uses and indeed requires a wooden frame or setting (See figures 1-3). See Scott Claims 1-3. Further, the 3-dimensional pattern on Scott is brick, not an artificial rock pattern. See Figures 1-3. Accordingly, the Applicant believes the Claim invention is not anticipated by Scott.

Response to 103 Rejections

The Applicant believes the claims as amended sufficiently distinguish the Applicant's invention from the cited references.

Combination of Bryant and Groves improper in rejecting Claim 1-6

The Applicant respectfully disagrees with the Examiner's combination of Bryant and Groves due to the references teaching away from any potential combination, in addition to impossibility and impracticality. While the Applicant acknowledges that the Examiner is combining Bryant with Groves for the 3-D rock pattern, the Applicant still submits the disclosure and the purpose of Groves teaches away from using teaching in

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Bryant, even the 3-D rock pattern. In determining whether combine references the entire disclosure of the prior art must be considered. See MPEP 2145 X D. Further, when a proposed modification renders the prior art unsatisfactory for its intended purpose then it is improper to combine that art. MPEP 2145 X D. As argued in the previous office action, the main function and purpose of Groves is that the liner may be rolled up and placed in a cylindrical tube for easy transport and/or installation. Indeed, this is one of the unique features claimed in the invention and is taught throughout the Groves specification (fig. 9, col. 4 lines 10-14; col. 2, lines 1-6, claim 6). Because the entire Groves patent is directed to an easily removable and portable decorative system, one skilled in the art would not consider Bryant, as Bryant's system is permanently, semi-permanently attached to the window well.

Additionally, the Applicant resubmits his arguments that another of the main purposes of Groves would be impeded and made non-functional if the 3-D rocks were to be combined with Groves. Indeed, as disclosed previously a proposed modification cannot render or impede the purpose of a reference. First, the Applicant acknowledges the Examiner's argument there is no indication Bryant would act this way with Bryant. Taking that in consideration, the reason why there is no teaching of this in Bryant is because the purpose of Bryant is to be permanently/semi-permanently attached, not to be rolled up. Therefore, Bryant would not disclose this teaching. According the physical properties associated with 3-dimension liners, such as Bryant, attempting to roll up such liners would cause the rolled up liner to be extremely bulky and unstable. These physical properties are inherent in any liner containing 3-dimesional objects and are clearly

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recognizable by one skilled in the art. This bulkiness and instability would teach and impede the Grover invention, as previously described.

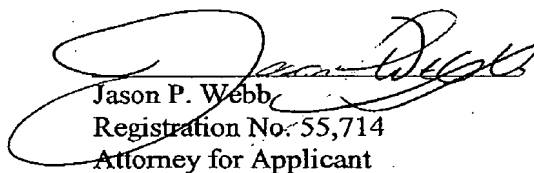
Rock-shaped protrusion is not merely decorative but functional

The Applicant additionally submits the amendments to Claim 1 of rock-shaped protrusions is not merely a decorative limitation but has functional properties associated with the Applicant's invention. The rock-shaped protrusions provide the functional advantage of assisting to prevent cracking and/or breaking of the three-dimensional rock protrusion and liner during the removal of the liner from the mold. In contrast, other protrusions (i.e., those in Scott) can break and/or chip upon attempted removal. While this particular benefit was not expressly described in the original specification, the non-obvious advantages are physically inherent throughout the molding process. Further, the Applicant acknowledges changes in shape, aesthetic appearance is generally considered obvious features, however, when considering obviousness, the invention as whole must be considered.

For these reasons, it is believed that none of the prior art teaches the claimed invention. Furthermore, it is believed that the foregoing amendment has adequate support in the specification, and accordingly there should be no new matter. Applicant believes the pending claims have addressed each of the issues pointed out by the Examiner in the Office Action. In light of the foregoing amendments and remarks, the claims should be in a condition for allowance. Should the Examiner wish to discuss any of the proposed changes, Applicant again invites the Examiner to do so by telephone conference.

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Respectfully Submitted,



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